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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,310	10/07/2003	Gerry Turner	VOICC.65619	5460

27629 7590 11/04/2004

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EXAMINER

CHOW, MING

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/680,310

Applicant(s)

TURNER ET AL.

Examiner

Ming Chow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-33 is/are pending in the application.
- 4a) Of the above claim(s) 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-21 and 23-30 is/are rejected.
- 7) ☒ Claim(s) 31-33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 15-21, 23-33, drawn to voice cards with sound-producing means, classified in class 40, subclass 124.03.
 - II. Claim 22, drawn to an audio message signal recording and reproduction, classified in class 379, subclass 68.
2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention II (method of message recording and delivering) does not require the particulars of the invention I. The subcombination has separate utility such as recorder-imprinter and pre-determined configurations.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
3. During a telephone conversation with Michael Doll a provisional election was made with traverse to prosecute the invention of 10/680310, claims 15-21, 23-33. Affirmation of this

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election must be made by applicant in replying to this Office Action. Claim 22 was withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is advised that the reply to this requirement to be completed must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “prompting said personal message” is not clearly defined. It is unclear the phrase refers to “playing said personal message” or “prompting for said personal message”. The specification, on page 21, discloses the recorder-imprinter prompts the customer for recording.

Allowable Subject Matter

6. Claims 31-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior arts do not teach a setup of two different recorder-imprinters and uploading the personal message to the personal computer.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 15-20, 23-30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goetcheus et al (US: 5444767), and in view of Ohara et al (US: 6356626).

For claims 15, 23, 29, 30, Goetcheus et al teach on column 3 line 3-4 potable playback device (claimed "voice module") is a greeting card (claimed "product with a pocket").

Goetcheus et al teach on Fig. 4 and 5. The "sequencer" (item 60 Fig. 4) is the claimed "electrical contact"). The "EPROM memory" (item 52 Fig. 4) is the claimed "solid state

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memory". The "battery" (item 58 Fig. 4) is the claimed "power supply". The "external start switch" (Fig. 4) is the claimed "switch". The item 64 Fig. 4 is a speaker.

Goetcheus et al teach on Fig. 1 and Fig. 3 "store front playback device programmer system" is the claimed "recorder-imprinter device". Goetcheus et al also teach on item 47 Fig. 3 memory (for claimed "storage device"). Goetcheus et al also teach on item 44 Fig. 3 "processor" (claimed "microprocessor"). Goetcheus et al failed to teach "an electrical receptacle". However, Ohara et al teach on column 11 line 28 "receptacles".

Goetcheus et al teach on column 2 line 49-62 the voice message is downloaded from the store front system (claimed "recorder-imprinter") to the portable playback device (claimed "storage device").

It would have been obvious to one skilled at the time the invention was made to modify Goetcheus et al to have the electrical receptacle as taught by Ohara et al such that the modified system of Goetcheus et al would be able to support the receptacle to the system users.

Regarding claim 16, Goetcheus et al teach on column 2 line 19 to column 3 line 29 placing a telephone call to the recorder-imprinter device for recording the voice messages.

Goetcheus et al failed to teach "prompting the recording of said audio message". However, Ohara et al teach on column 9 line 34 recording LED light (claimed "prompt").

It would have been obvious to one skilled at the time the invention was made to modify Goetcheus et al and Ohara et al to have the "prompting the recording of said audio message" as taught by Ohara et al such that the modified system of Goetcheus et al and Ohara et al would be able to support the prompt to the system users.

Regarding claims 17 and 18, Goetcheus et al teach on item 12 Fig. 1 a personal computer system interfacing with the recorder-imprinter for transmitting voice messages.

Regarding claim 19, Goetcheus et al teach on column 5 line 53-61 various networks can be selected for connecting the computer and transmitting the voice messages (claimed “electronic data”).

Regarding claim 20, Goetcheus et al teach on column 2 line 25-29 the system is for generating personalized audio messages for greeting. The user of Goetcheus’ system must select a recorder-imprinter for generating the message.

Goetcheus et al teach on column 2 line 38-41 the message sender communicates via a telephone line with the central facility system. Therefore, the message sender must select a telephone network.

It is inherent that the telephone line connection must be installed between the network and telephone jack so that Goetcheus’ system can be operable as invented.

Goetcheus et al failed to teach “transferring.....incoming call”. However, Ohara et al teach on column 1 line 43-44 a button on the recorder-imprinter is pressed for seizing the call.

It would have been obvious to one skilled at the time the invention was made to modify Goetcheus et al and Ohara et al to have the “transferring.....incoming call” as taught by Ohara et al such that the modified system of Goetcheus et al and Ohara et al would be able to support the button to the system users.

Regarding claim 24, all rejections as stated in claim 15 above apply.

Ohara et al teach on item 170 Fig. 5, telephone jack.

Ohara et al teach on item 152 Fig. 5, a selection button.

Ohara et al teach on Fig. 10, microprocessor.

The “recorder-imprinter being located at a retail location is a “decide choice”.

It is inherent for “selecting a telephone network”, “installing a telephone line”, “placing a telephone call”, “receiving said telephone call” for the system as taught by Ohara et al.

Ohara et al teach on column 4 line 32-33, instruction to record is the claimed “prompting (for) said personal message”.

It would have been obvious to one skilled at the time the invention was made to modify Goetcheus et al in view of Ohara et al to have the telephone jack, selection button, microprocessor as taught by Ohara et al such that the modified system of Goetcheus et al in view of Ohara et al would be able to support the convenience of using telephone network to the system users.

Regarding claim 25, all rejections as stated in claims 15 and 17 above apply.

Regarding claim 26, see Fig. 1 of Goetcheus et al.

The “co-locating a user and said personal computer” is a “decide choice”.

Regarding claims 27, 28, the location is a “decide choice”.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goetcheus et al as stated in claim 15 above, and in view of Ohara et al and further in view of Johnson et al (US: 5155760).

The modified system of Goetcheus et al in view of Ohara et al as stated in claim 15 above failed to teach “locating.....selecting.....said user.....said microprocessor.....voice message”.

Ohara et al teach on column 4 line 13 “to record a voice message recording/playback device in person”. The “in person” of Ohara et al reads on the claimed “locating a user and said recorder-imprinter in the same location”.

Ohara et al teach on item 18 Fig. 1, point-of-sale telephone (reads on claimed “handset”).

It is inherent that the user must pick up the handset.

Johnson et al teach on column 1 line 14-18, a processor of a voice message system controls the prompt mechanism.

It would have been obvious to one skilled at the time the invention was made to modify Goetcheus et al and Ohara et al to have the “locating.....selecting.....said user.....said microprocessor.....voice message” as taught by Ohara et al and Johnson et al such that the modified system of Goetcheus et al in view of Ohara et al would be able to support the locating user, selecting recorder-imprinter, handset, and prompting to the system users.

Conclusion

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9. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- Bartholomew et al (US-PAT-NO: 6,215,858) teach analog terminal internet access.

10. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to Central FAX Number 703-872-9306.

Patent Examiner

Art Unit 2645

Ming Chow



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600